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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,406	06/19/2001	Eiichi Okazaki	7378/71294	1315

22242 7590 07/31/2002

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EXAMINER

MCCLENDON, SANZA L

ART UNIT PAPER NUMBER

1711

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/883,406

Applicant(s)

OKAZAKI ET AL.

Examiner

Sanza L McClendon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-15 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) 21, 23 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 20 is/are rejected.
- 7) ☒ Claim(s) 10-15, 22 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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DETAILED ACTION

*Election/Restrictions*

1. Applicant's election of Groups I in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). With regard to the restriction requirement by the examiner mailed April 9, 2002, there was a error with regards to the grouping of claims the corrected groupings are listed below for clarity. The reasons set forth in said restriction requirement still stand and are therefore not re-written below. Please refer to paper number 6 for more detail reasoning.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 10-15, 20, 22, and 24, drawn to composition, classified in class 522, subclass 152.
- II. Claims 21, 23, and 25, drawn to method, classified in class 427, subclass 487.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al (4,416,975).

Green et al teaches photopolymerizable processes employing compounds containing acryloyl groups and maleimide groups. Said compounds (A) can be represented by formulas III, IV, VIIIXI, XV, XVI, and others listed

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throughout the disclosure of Green et al. Said acrylate and maleimide groups are connected via an ester linkage. Said processes involve photopolymerizing using actinic radiation a composition comprising compound (A), a photoinitiator, a compound (B), and optionally, a compound (C). Said compound (B) can be an acrylic or methacrylic ester of a hydroxyalkyl or an alkyl compound.

These teachings appear to anticipate the curable resin composition of claims 1-5 and 20.

5. Claims 1-7 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Okazaki et al (WO 98/58912).

Okazaki et al teaches acrylates and actinic radiation curable compositions comprising said acrylates. Said acrylates of Okazaki et al are imido (meth) acrylates of general formula 1, wherein the methacrylate moiety is connected via an ester linkage. Said compositions comprising imido methacrylates of Okazaki et al can comprise other monomers and oligomers having methacrylate or acrylate groups. For instance, monomers having mono or poly functional polymerizable groups can be added, such as those listed in column 6, lines 25 to the end, in addition oligomers and polymers having one or more polymerizable groups can be added. Photoinitiators are present for polymerization by actinic radiation, in addition to other additives, such as ultraviolet absorbers and the like. These compositions are suitable for coating wood, paper, metals, and plastics.

The inventions of claims 1-7 and 20 appear to be anticipated by the reference.

#### *Allowable Subject Matter*

6. Claims 10-15, 22, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach an aqueous coating composition

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comprising a polymer, which contains a maleimido group and an ethylenically unsaturated group as defined by applicant's claims.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 2001-172336 is currently being translated to see if it is pertinent to applicant's claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (703) 305-0505. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

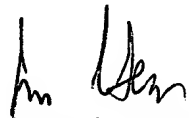
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0657.

Sanza L McClendon  
Examiner  
Art Unit 1711

SMc

July 15, 2002

  
James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700